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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,675	08/05/2003	Shinji Fujikawa	S0530.0001	6901
32172	7590	12/08/2005		
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 1177 AVENUE OF THE AMERICAS (6TH AVENUE) 41 ST FL. NEW YORK, NY 10036-2714			EXAMINER KASZTEJNA, MATTHEW JOHN	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 12/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 10/633,675	Applicant(s) FUJIKAWA ET AL.	
	Examiner Matthew J. Kasztejna	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4, 6 and 10-17 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 4 and 6 is/are allowed.
- 6) ☒ Claim(s) 10-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☒ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Notice of Amendment***

In response to the amendment filed on September 20, 2005, amended claims 1, 4, 6 and 10; and cancelled claims 2, 3, 5, 7-9 and 18 are acknowledged. The rejections of claims 1, 4 and 6 are *withdrawn*. Claims 10-17 *stand rejected*. The following new and reiterated grounds of rejection are set forth:

### ***Claim Objections***

Claim 15 is objected to because of the following informalities: "a plurality of protrusions held to be wound around the scope unit" appears to be written incorrectly in view of the specification and Fig. 20a. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,066,089 to Costello et al.

**In regards to claim 10**, Costello et al. disclose an endoscope apparatus comprising: a scope unit having flexibility, the scope unit being inserted into a space targeted for inspection to be observed and having a connector portion provided at a proximal end side thereof, an apparatus main body being capable of constructing an integral endoscope main body by being assembled with the connector portion; an

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endoscope housing case 100 which houses the scope unit and the apparatus main body therein, and an insert portion holding member 108 which holds the scope unit, the holding member being attachable to/detachable from any one of the connector portion, the endoscope main body, and the apparatus main body (see Col. 9, Lines 44-47 and Col. 11, Lines 1-25 and Fig. 1).

Claims 14 and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,314,070 to Ciarlei.

**In regards to claim 14**, Ciarlei discloses an endoscope apparatus comprising: a scope unit 14 having flexibility, the scope unit being inserted into a space targeted for inspection to be observed, and having a connector portion 17 provided at a proximal end pad side thereof; a connector portion which controls flexible bending and observation of the scope unit (see Col. 2, Lines 45-50); an apparatus main body 22 capable of controlling the connector portion and constructing an integral endoscope main body by being assembled with the connector portion (see Col. 2, Lines 51-63); an endoscope housing case 11 which houses the scope unit and the apparatus main body therein; and an insert portion holding member 24 which holds the scope unit and is provided at the endoscope main body (see Fig. 1).

**In regards to claims 16-17**, Ciarlei discloses an endoscope apparatus wherein a coil 24 houses the insertion tube 14 of the endoscope (see Fig. 2). This configuration provides better protection and prevents crushing of the insert portion.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,066,089 to Costello et al. in view of U.S. Patent No. 5,314,070 to Ciarlei.

**In regards to claims 11-12**, Costello et al. disclose an endoscope apparatus but are silent with respect to an intermediate linking portion. Ciarlei teaches of an analogous apparatus having a control section 17 positioned at the proximal end of the flexible insertion tube which controls flexible bending and observation of the scope unit (see Col. 2, Lines 36-64). It would have been obvious to one skilled in the art at the time the invention was made to have an intermediate linking section in the apparatus of Costello et al. to allow for control of the insert portion of the endoscope as taught by Ciarlei.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,066,089 to Costello et al. in view of U.S. Patent No. 5,863,286 to Yabe et al.

**In regards to claim 13**, Costello et al. disclose an endoscope apparatus but are silent with respect to an intermediate linking portion having a forceps inserting base connected to the manipulating device inserting channel and having an axis which is

coincident with an axis of the manipulating inserting channel. Yabe et al. teach of an analogous apparatus having a forceps channel and a forceps inlet opening through which a forceps can be inserted (see Fig. 5). It would have been obvious to one skilled in the art at the time the invention was made to have an intermediate linking section with a forceps inlet in the apparatus of Costello et al. to allow for the insertion of an instrument to the targeted site as taught by Yabe et al.

Claims 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,314,070 to Ciarlei in view of U.S. Patent No. 5,323,899 to Strom et al.

**In regards to claim 15**, Ciarlei discloses an endoscope apparatus but are silent with respect but is silent with respect to wherein the insert holding member is a plurality of protrusion which the scope unit is wound about. Strom et al. teach of an analogous endoscopic apparatus wherein the scope unit 100 is capable of being wound about protrusions 105 and further secured with a bracket 108. It would have been obvious to one skilled in the art a the time the invention was made to secure the scope around a plurality of protrusions in the apparatus of Ciarlei so as to allow a secure holding means of the scope as taught by Strom et al.

#### ***Allowable Subject Matter***

Claims 1, 4 and 6 are allowed.

#### ***Response to Arguments***

Applicant's arguments filed September 20, 2005 have been fully considered but they are not persuasive. Applicant states Costello fails to disclose the insert portion member that is attachable to and detachable from an endoscope main body. However,

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insert portion holding member 108 is disclosed as being a hinged section. Therefore, as broadly as claimed, the holding member 108 is attachable to and detachable from the endoscope main body.

Applicant's arguments with respect to claims 14 and 17 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJK



11/29/05



BEVERLY M. FLANAGAN  
PRIMARY EXAMINER